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Paper No. 11
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DTI Partnership, L.L.P.

Serial No. 76197856
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Glenn M. Seager of Crompton, Seager & Tufte, LLC for DTI Partnership, L.L.P.

Angela M. Micheli, Trademark Examining Attorney, Law Office 108 (David E. Shallant, Managing Attorney).

Before Hairston, Walters and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

In the three above-referenced applications, applicant has applied for registration on the Principal Register of the marks IBLOCK, IBLOCKS, and IBLOCK TREND WATCH (all in typed form) for goods identified in the applications, as

amended, as "computer software used to perform data analysis in the field of demographics."¹

In each of the three applications, the Trademark Examining Attorney has finally refused registration of the marks on the ground that the mark is merely descriptive and thus unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and on the alternative ground that applicant has failed to comply with the Trademark Examining Attorney's requirement for information pursuant to Trademark Rule 2.61(b), 37 C.F.R. §2.61(b).

Applicant has appealed in each case. In each case, applicant and the Trademark Examining Attorney filed opening briefs on appeal, but applicant did not file a reply brief and did not request an oral hearing. Because the three cases involve common issues of law and/or fact, we shall decide them in this single opinion.

In each case, we affirm the refusal to register, based on applicant's failure to comply with (or even acknowledge) the Trademark Examining Attorney's requirement for information under Trademark Rule 2.61(b).

¹ All three applications were filed on January 22, 2001 and are based on applicant's asserted intent to use the mark, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

The facts of these cases are essentially identical to those recited in our precedential decision affirming the Trademark Examining Attorney's refusal of registration in applicant's application to register the mark IBLOCK THERMAL MAPS. *In re DTI Partnership, L.L.P.*, 67 USPQ2d 1699 (TTAB 2003). Familiarity with that decision is presumed.

In these cases as in that case, the Trademark Examining Attorney, in her first Office action, made a mere descriptiveness refusal and attached evidence in support of that refusal. She also made the following requirements:

The applicant must submit samples of advertisements or promotional materials for goods of the same type to permit proper consideration of the application. If such materials are not available, the applicant must submit a photograph of similar goods and must describe the nature, purpose and channels of trade of the goods. 37 C.F.R. Section 2.61(b); TMEP sections 1103.04 and 1105.02.

The applicant must indicate whether the wording in the mark has any significance in the relevant trade or industry or as applied to the goods. 37 C.F.R. Section 2.61(b).

In its response to the first Office action in each case, applicant presented arguments in opposition to the mere descriptiveness refusal, including detailed arguments as to why the evidence made of record by the Trademark Examining Attorney failed to establish mere

descriptiveness. Applicant did not specifically address or acknowledge the Trademark Examining Attorney's requirement for information under Trademark Rule 2.61(b).

In her final Office action in each case, the Trademark Examining Attorney presented further arguments and evidence in support of her mere descriptiveness refusal and made that refusal final. She also reiterated her requirement under Trademark Rule 2.61(b) that applicant submit the requested information and materials.

Applicant then filed a notice of appeal and a request for reconsideration of the final refusal in each case. The Board instituted and suspended the appeal, and remanded the application to the Trademark Examining Attorney for examination of the request for reconsideration. In the request for reconsideration, applicant once again merely presented arguments as to why the Trademark Examining Attorney's evidence failed to establish that its mark is merely descriptive. Applicant did not comply with or acknowledge the Trademark Examining Attorney's final Trademark Rule 2.61(b) requirement for submission of additional information and materials.

The Trademark Examining Attorney issued an action in each case denying the request for reconsideration. The Board then resumed the appeal, and applicant filed an

appeal brief which essentially is a verbatim reiteration of its request for reconsideration. Applicant's appeal brief included no response to or even acknowledgement of the pending final Trademark Rule 2.61(b) requirement.

Likewise, although the Trademark Examining Attorney specifically argued in a separately-headed section of her brief on appeal that applicant has failed to comply with the outstanding Trademark Rule 2.61(b) requirement and that such failure constitutes an independent basis for refusing registration, applicant did not file a reply brief addressing this issue.

The Trademark Rules of Practice have the effect of law, and failure to comply with a request for information is grounds for refusal of registration. *See In re DTI Partnership, L.L.P., supra; In re SPX Corporation*, 63 USPQ2d 1592 (TTAB 2002); *In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999); *In re Babies Beat, Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371 (TTAB 1978); *In re Air Products and Chemicals, Inc.*, 192 USPQ2d 84, 85-86 (TTAB 1976); and *In re Morrison Industries, Inc.*, 178 USPQ 432, 433-34 (TTAB 1973); *see generally Chrysler Corp. v. Brown*, 441 U.S. 281, 295 (1979)(agency regulations have the force and effect of law).

Trademark Rule 2.61(b) provides: "The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." We find that the Trademark Examining Attorney's requirement in each case for information (regarding the nature of applicant's goods and the significance of the wording in the mark as applied to such goods) was proper under Trademark Rule 2.61(b). Such information is directly relevant to the issue of mere descriptiveness and thus "may be reasonably necessary to the proper examination of the application," as required by the rule. Applicant has not contended otherwise.

We also find that applicant, in each case, has failed to comply with the Trademark Examining Attorney's Trademark Rule 2.61(b) requirement. Again, applicant has not contended otherwise. Applicant's noncompliance with the Trademark Examining Attorney's lawful requirement under Trademark Rule 2.61(b) warrants rejection of the application in each case. *See In re DTI Partnership, L.L.P., supra; In re SPX Corporation, supra; In re Page, supra; and In re Babies Beat, Inc., supra.*

Indeed, despite the Trademark Examining Attorney's repeated express warnings and reminders, applicant inexplicably has ignored the Trademark Rule 2.61

requirement altogether, both during prosecution of the applications and during these appeals. Such disregard of the Trademark Examining Attorney's lawful requirement, even more than applicant's noncompliance therewith, warrants rejection of the application. As the Board has stated previously:

In response to a request for information such as the Examining Attorney made in this case, an applicant has several options. It may comply with the request by submitting the required advertising or promotional material. Or it may explain that it has no such material, but may submit material of its competitors for similar goods or provide information regarding the goods on which it uses or intends to use the mark. Or it may even dispute the legitimacy of the request, for example, if the goods identified in the application are such ordinary consumer items that a request for information concerning them would be considered unnecessary and burdensome. What an applicant cannot do, however, is to ignore a request made pursuant to Trademark Rule 2.61(b), as applicant has here.

In re SPX Corporation, supra, 63 USPQ2d at 1597.

For the reasons discussed above, we affirm the refusals to register in each of the three applications, based on applicant's failure to comply with the Trademark Examining Attorney's final requirement for information under Trademark Rule 2.61(b).

In view of our decision with respect to the Trademark Rule 2.61(b) requirement in each case, we deem the substantive Section 2(e)(1) mere descriptiveness refusal in each case to be moot. Applicant's failure to comply with the Trademark Rule 2.61(b) requirement is a sufficient basis, in itself, for affirming the refusals to register applicant's marks. Moreover, our ability to fully and accurately assess the substantive merits of the mere descriptiveness refusals has been hindered by applicant's failure to submit the information and materials which were properly requested by the Trademark Examining Attorney under Trademark Rule 2.61(b). *See In re DTI Partnership, L.L.P., supra.* In these circumstances, we decline to reach the merits of those refusals.

Decision: In each of the three applications captioned above, the refusal to register based on applicant's failure to comply with the Trademark Examining Attorney's final requirement for information under Trademark Rule 2.61(b) is affirmed. The Section 2(e)(1) mere descriptiveness refusal in each case is moot.